

Application No.: 10/536,621  
Filing Date: May 26, 2005

**REMARKS**

No Claims has been amended. Accordingly no new matter has been added. Applicants respectfully request reconsideration of the application in view of the following remarks.

**Claim Rejections – 35 U.S.C. § 102**

Claims 1, 7, 8, 10, 11, and 13-21 have been rejected under 35 U.S.C. § 102 (e), as being anticipated by Shimomura et al. (US2005/0064709). The Examiner asserts that Shimomura et al teach that a grinding pad with a polishing region and light-transmitting region, however, Shimomura et al. does not describe the light-transmitting region as claimed. In particular, it has no light transmitting region at all, much less one having any of the characteristics recited as (i), (ii) or (iii) in Claim 1, 12, and 20. The present claimed invention contains subject matter that the cited reference does not have. Applicants respectfully request withdrawal of the rejection. Please note that Claim 8 was canceled.

**Claim Rejections – 35 U.S.C. § 103**

Claims 1, 7, 10, 13, and 15 have been rejected under 35 U.S.C. § 103, as being unpatentable over Takahashi et al. in view of Halley. In previous amendment, Claims 1, as well as Claims 12 and 20, have been amended by reciting the material to be polished as an expressed part of the body of the claims and by reciting “a length (D) in a diametrical direction is 1/4 to 1/2 relative to a diameter of a material to be polished.” Although, we have argued that Takashi does not disclose the ratio of length D to the diameter of wafer as an object of wafer, the Examiner interprets this limitation as a matter of an intended use. However, because the material to be polished itself is recited in the body of the claim through the recitation of “comprising said material”, the ratio is a positive limitation and not an indented use.

Further, the Examiner is also mistaken that there is no support for a recitation of the ratios of 0.28 and 0.49 in the remarks of the previous amendment. As stated in the specification at page 44, line 23, the evaluation was conducted using an 8-inch wafer and the length D for each samples are disclosed, consequently the ratios for the Examples 6-9 and Comparative Examples 3-5 can be calculated as 0.28, 0.49, 0.28, 0.28, 0.09, 0.15, and 0.25, respectively.

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The Examiner stated that the Amendment failed to provide criticality of the claimed ratio range. However, the Applicants provided to the foregoing examples and Table 3 to show that ratios below the claimed range performed poorly compared to those within the claimed range. In addition, Applicants submits herewith a Declaration under 37 C.F.R. § 1.132, showing a poor Polishing Rate with the ratio of 6.8, well above the claimed range. Thus, the data in Table-3 in the specification and in the Declaration show the criticality of the range. Moreover, the specification state that “when the length D is greater than 1/2, the polishing region is decreased, and thus the efficiency of polishing tends to be lowered.” (Page 13, lines 17-19). Accordingly, the Claims 1, 12, and 20 recite a novel feature that produces unexpected results.

Further, the Examiner mistakenly equates Halley’s disclosure about the ratio between a pad and a wafer to be polished with the recited ratio between the length (D) and a wafer of the present invention. The ratios disclosed by Halley are not relevant to the claimed invention. Applicants respectfully request withdrawal of the rejection.

The rest of the rejected claims depend from Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicants respectfully submit that the dependent claims are patentable over the prior art.

#### Claim Rejections – 35 U.S.C. § 103

Claims 1-4 and 7 have been rejected under 35 U.S.C. § 103, as being unpatentable over Hasegawa Toru. in view of Halley. Since the cited references are silent about the ratio of length (D) to the diameter of wafer. The same argument is applicable. Applicants respectfully request withdrawal of the rejection.

#### Claim Rejections – 35 U.S.C. § 103

Claims 14, 16, and 17 have been rejected under 35 U.S.C. § 103, as being unpatentable over Hasegawa Toru. in view of Halley, and further view of Kouchiyam et al. Since the cited references are silent about the ratio of length (D) to the diameter of wafer. The same argument is applicable. Applicants respectfully request withdrawal of the rejection.

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Claim Rejections – 35 U.S.C. § 103

Claims 2-4, 12, and 20 have been rejected under 35 U.S.C. § 103, as being unpatentable over Takashi pr Hasegawa Toru, in view of Halley. Since the cited references are silent about the ratio of length (D) to the diameter of wafer. The same argument is applicable. Applicants respectfully request withdrawal of the rejection.

**CONCLUSION**

In view of Applicant's foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

*No Disclaimers or Disavowals*

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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